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Supreme Court, U.S.
FILED
JUN 15 2001
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No. 99-1996

IN THE
Supreme Court of the United States

J.E.M. AG SUPPLY, INC., FARM ADVANTAGE, INC., LARRY BENZ, MERLE PRUETT, KEVIN WOLFSWINKEL, TIM KAMSTRA, and TOM EISCHEN SEED & CHEMICALS,
Petitioners,

v.

PIONEER HI-BRED INTERNATIONAL, INC.,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENT

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WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20001

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QUESTION PRESENTED

Whether plants developed by human intervention, and associated seeds and other plant parts, are patentable subject matter under 35 U.S.C. § 101.

CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, respondent states that it is a wholly owned subsidiary of E.I. du Pont de Nemours and Company.

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BRIEF FOR RESPONDENT

STATEMENT

This case involves plants developed thorough extensive human efforts, providing substantial benefits for agriculture. The United States issued patents to protect the results of those efforts, applying the normal standards for utility patents. Both courts below upheld the patents, ruling that such plants are patentable subject matter like any other technological development.

A. Plant Reproduction

Plant reproduction (multiplication or propagation) is commonly divided into sexual and asexual methods. The same plant is often capable of reproduction in both ways, whether naturally or artificially. Practical considerations determine which method is used for commercial purposes.

Sexual reproduction involves fertilization, the union of male (pollen) and female (ovule) cells—gametes (or "germ" cells)—to produce a fertilized seed that can grow into the

plant. Self-fertilization occurs if the male and female gametes come from a single individual, with pollen fertilizing the ovules inside the flowers on the same individual. (For corn, pollen from the tassels at the top of the stalk may be deposited on the silks protruding from the corn ears, one silk leading to each ovule.) Cross-fertilization occurs if the gametes are from different individuals, even if genetically similar. A "hybrid" results from the cross-fertilization of plants that are of different varieties, *i.e.*, plant lines that are genetically distinct. *See* JA 29 (patent at issue); 1 W. Fehr, *Principles of Cultivar Development* 11-25 (1991).

In sexual reproduction, the sex cells may have different genetic makeup, because the chromosomes (even if from the same individual) may differ at various gene locations along the chromosome (there are roughly 60,000 gene locations in corn plants): one may contain the dominant version of the particular gene (*e.g.*, tall), the other the recessive (*e.g.*, short). For such "heterozygous" plants, sexual reproduction produces nonuniform offspring. In particular, the plant grown from hybrid seed will produce seeds of nonuniform characteristics, so that hybrids are not genetically stable after the first generation; as a result, seed from one year's hybrid crop cannot be used to re-grow the same hybrid crop, which instead requires seed from crossing the same parental lines that produced the hybrid seed in the first place. On the other hand, to produce "inbred" lines, a plant breeder, by repeated controlled fertilization over many generations, and with appropriate selection of offspring with the desired characteristics, can largely weed out undesirable traits and produce "homozygous" plants that have near-uniform genetic makeup in the desired characteristic. *See* JA 29; Fehr, *supra*, at 29, 34, 106-14, 428-38. Such plants are used as parental lines for producing hybrid seed.

Asexual reproduction is reproduction without fertilization, *i.e.*, without union of male and female cells. Some plants

(*e.g.*, some grasses, dandelions) reproduce this way in nature, such as by sending out runners along the ground, or putting out underground stems, that in turn produce new plants. *See* P. Raven, R. Evert & S. Eichhorn, *Biology of Plants* 179-80 (6th ed. 1999). Many other plants, however, even those which reproduce through fertilized seeds in nature, can be artificially reproduced without fertilization by established human-engineered methods, *e.g.*, grafting one piece of the plant onto a root piece, resulting in growth of a new plant. *See* S. Rep. 315, 71st Cong., 2d Sess. 1 (1930) ["1930 Senate Report"]; H.R. Rep. 1129, 71st Cong., 2d Sess. 1 (1930) ["1930 House Report"]; H. Hayes & R. Garber, *Breeding Crop Plants* 95 (2d ed. 1927) ("grafting, cutting, layering"). Except for inevitable (but unpredictable) mutations, asexual reproduction creates a genetic copy, or clone, of the parent. *Id.*

The very same plant variety may be reproduced in both ways. *See* U.S. Office of Technology Assessment, *Patenting Life* 79 (1989) ("Although crops can be classified by their natural reproductive processes, some crops can be propagated either sexually or asexually."). For some plants, such as strawberries, both methods occur naturally. *See* Raven, Evert & Eichhorn, *supra*, at 179-80, 255. For many others, human-aided asexual reproduction can be applied to clone plants that were initially developed through sexual breeding programs. Thus, a grape vine or an apple tree that produces seeds from sexual reproduction, and has been developed through hybrid cross-fertilization to bring out a particular feature, can be cloned by asexual methods to guarantee repetition in the offspring of the desired feature.[1] For particular plants, the

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[1] *See, e.g.*, 35 U.S.C. § 161 (referring to "hybrids" that have then been asexually reproduced); 1930 Senate Report at 3, 7 (discussing hybridization to produce plants to be protected); 1930 House Report at 4, 8 (same); H. Hayes & R. Garber, *supra*, at 13, 350-57 (discussion of crossing to produce new varieties that then "may be propagated

method of reproduction used by breeders, farmers, nurseries, and others depends as much on commercial and other practical considerations as on biological constraints.

B. Statutory Framework

For some plants, state trade-secret law provides a useful form of protection for plant breeders, though at a cost of curtailed public disclosure. The developer of a hybrid seed, for example, may hold secret the inbred-line parents needed to create new quantities of the hybrid seed. *See Pioneer Hi-Bred Int'l v. Holden Foundation Seeds, Inc.*, 35 F.3d 1226 (8th Cir. 1994); *Patenting Life* at 82 ("Historically, the hybrid corn industry has depended heavily on trade secret protection of parental lines.") (citation omitted). There are, in addition, three federal statutory regimes relevant to the protection of plant life, each involving different qualifications and different degrees of public disclosure.

1. Utility Patents: 35 U.S.C. § 101

Methods of breeding plants have long been protected, as processes, under Section 101 of the Patent Act of 1952, 35

asexually"); Plant Patent No. 2 (claimed new plant originated by artificial crossing); Plant Patent No. 6 (same); Fehr, *supra*, at 381-87; *see also* 1930 Senate Report at 5 ("theoretically under laboratory conditions it is probable that all plants can be asexually reproduced"); 1930 House Report at 6 (same); *In re LeGrice*, 301 F.2d 929, 1136 (CCPA 1962) ("The rose breeder strives to produce by sexual propagation a rose having the desired characteristics, after which this particular rose with the desirable characteristics is further propagated by asexual methods in which all of the characteristics of that one rose plant, and only that plant, are transmitted to the new plants derived by cutting, etc."); Rossman, *Plant Patents*, 13 J.P.O. Soc'y 7, 13 (1931) ("The cross-pollinization or hybridization of different kinds of seedlings produces the great majoriy of our new plants. They are created by the plant-breeder when he artificially fertilizes one variety with the pollen from another variety.").

U.S.C. § 101, and its predecessors.[2] Since at least 1985, when the Board of Patent Appeals and Interferences of the Patent and Trademark Office (PTO) decided *In re Hibberd*, 227 USPQ 443, following this Court's decision in *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), the PTO has issued patents on plants themselves under Section 101.[3] The industry has relied on *Hibberd*: by 1998, more than 1600 patents with claims to "plants" had been issued. JA 21.

Section 101, except for the 1952 replacement of the term "art" with the term "process" (a change not relevant here), uses language that Congress enacted in 1793 and has carried forward without change since that time.[4] The 1952 Act, in particular, simply recodified the language without alteration. *Chakrabarty*, 447 U.S. at 308-09; *In re Bergy*, 596 F.2d 952, 973 (CCPA 1979), *aff'd*, 447 U.S. 303 (1980).[5] Section 101

[2] *See Plant Patents*, Hearing before the House Comm. on Patents, 71st Cong., 2d Sess. 5-6 (1930) ["1930 House Hearing"] (Commissioner of Patents: "For many years past patents have been granted for methods of grafting, etc., ..."); JA 52 (Boehm patent); JA 56 (Maan patent); JA 66 (Hayward patent).

[3] At least some "utility" patents on plants or seeds—specifically and separately claimed as the product of certain claimed breeding processes—were issued prior to 1985. *See* JA 52 (1936 Boehm patent, U.S. Patent No. 2,048,056); JA 56 (1979 Maan patent, U.S. Patent No. 4,143,486); JA 66 (1983 Hayward patent, U.S. Patent No. 4,406,086). Although petitioners suggested otherwise as to the Boehm patent in their Reply Brief at the petition stage (at 3-4), the numbering of the patents is enough to show them plainly to be utility patents, since plant patents are separately numbered, beginning with 1 after the 1930 and today reaching roughly 12,000.

[4] *See, e.g.*, Patent Act of 1793, ch. 11, § 1, 1 Stat. 318, 319; Patent Act of 1836, ch. 357, § 6, 5 Stat. 117, 119; Patent Act of 1870, ch. 230, § 24, 16 Stat. 198, 201; Rev. Stat. § 4886; 35 U.S.C. § 31 (1946 ed.); H.R. Rep. 1923, 82d Cong., 2d Sess. 37-38 (1952) (quoting Section 101 predecessors).

[5] The 1952 committee reports specifically discuss the changes in language that were intended as substantive in what was otherwise

allows a patent, if other requirements are met, to any person who

> invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

The patent, if obtained, broadly protects against unauthorized manufacture, use, sale, offer, or importation. *See* 35 U.S.C. §§ 154, 271.

The additional requirements that must be met to obtain a patent for subject matter within that broad class include the following: (a) usefulness, 35 U.S.C. § 101; (b) novelty, 35 U.S.C. § 102[6]; (c) non-obviousness in light of prior art, 35 U.S.C. § 103; (d) definiteness in the claims defining the protected inventions, 35 U.S.C. § 112, ¶ 2; (e) an enabling written description, *i.e.*,

> a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same,

35 U.S.C. § 112, ¶ 1; and (f) an identification of "the best mode contemplated by the inventor of carrying out his invention," 35 U.S.C. § 112, ¶ 1. For a patentee claiming biological materials to meet the demanding disclosure standards of Section 112, ¶ 1, it is often necessary to place samples of the materials on deposit in an authorized and

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generally a nonsubstantive recodification. H.R. Rep. 1923, *supra*; S. Rep. 1979, 82nd Cong., 2d Sess. (1952). There is no mention of any intended substantive change with respect to the language of Section 101 at issue. *See* H.R. Rep. 1923, at 6, 16-17.

[6] Section 102 includes various requirements that the invention not have been anticipated by certain prior art such as publications and patents, abandoned by the applicant, or invented by someone else. 35 U.S.C. § 102.

identified depository. 37 C.F.R. §§ 1.801-1.809; 3 D. Chisum, *Patents* § 7.03[5][b]; U.S. PTO, *Manual of Patent Examining Procedure* §§ 2401-2411.05 ["*MPEP*"]. Fulfilling Section 112's disclosure purpose, the PTO requires that the deposit, from the time of the patent's issuance, be available to any member of the public to ascertain fully the teachings of the patent. 37 C.F.R. § 1.808; *MPEP* § 2410.01.

2. Plant Patent Act of 1930: 35 U.S.C. §§ 161-164

Congress added a new form of protection in 1930, enacting the Plant Patent Act of 1930, ch. 312, 46 Stat. 376. Congress was informed that plants were not at the time qualifying for protection under the patent laws, based on a "belief" (not tied to any authoritative judicial construction) that plants were products of nature and, in addition, were "'not amenable to the 'written description' requirement" (then in Rev. Stat. § 4888 and now in 35 U.S.C. § 112, ¶1). *Chakrabarty*, 447 U.S. at 312; *see* 1930 Senate Report at 9 (letter from Secretary of Agriculture explaining that "the patent laws . . . at the present time are understood to cover only inventions or discoveries in the field of inanimate nature" and, also, required written description not understood to be available for plants); 1930 House Report at 10 (same); 1930 House Hearing at 5-7 (Commissioner of Patents memorandum). In response, Congress added new patent protection for certain plant varieties without the need to meet all the otherwise-applicable requirements of the patent laws. The provisions of that Act were re-codified in 1952, without substantive change, to appear at 35 U.S.C. §§ 161-164, and broadened twice thereafter (in 1954 and 1998). Patents issued under those provisions have been separately numbered since 1930, with the consecutive numbering now at roughly 12,000.

The Plant Patent Act originally authorized patents for those who have "invented or discovered and *asexually reproduced* any distinct and new variety of plant, other than a tuber-

propagated plant" (emphasis added), and Section 161 today reaches

> [w]hoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state.[7]

Administratively since the beginning, and statutorily since 1952, only a single claim identifying "the plant shown and described" has been allowed. 35 U.S.C. § 162; 37 C.F.R. § 1.164. Although the plant claimed may have been created by sexual reproduction and may be capable of further sexual reproduction, the patent applicant must have "asexually reproduce[d]" it at least once, ensuring that the characteristics that make it "distinct" were not an environmental accident but are genetically based, reproducible in a clone, hence characteristic of a new "variety." *See Dunn v. Ragin v. Carlile*, 50 USPQ 472 (Bd. Interf. Exam'rs 1941). Section 163 defines the scope of protection: it bars further cloning as well as associated activities (*e.g.*, using, selling, importing) involving the plant or its clone or, since 1998, flowers or other parts of the plant or its clone.[8]

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[7] The original 1930 language was written as a clause within Rev. Stat. 4886 following the language, quoted above, that is now in Section 101. *See* Pet. App. 42; Pet. Br. 17-18 n.5.

The language "including cultivated sports, mutants, hybrids, and newly found seedlings," and "other than . . . a plant found in an uncultivated state," were added in 1954. Pub. L. No. 775, ch. 1259, 68 Stat. 1190 (1954).

[8] *See* Pet. Br. App. 27a (current Section 163); Pet. App. 44 (pre-1998 Section 163). One textual point is worth noting. Whereas current Section 163 says that the grant "shall *include*" the right to exclude others from the specified activities, the pre-1998 version said that the grant "shall *be of*" that right. 35 U.S.C. § 163 note; Pet. App. 44 (1952 version). The original 1930 Act, like the current version, used "include" language: "including in the case of a plant patent the exclusive right to asexually

A broader class of plants may be awarded a plant patent than could qualify for a utility patent. In particular, under Section 162, protection is afforded to plant varieties that cannot be adequately described in compliance with Section 112. 35 U.S.C. § 162 ("No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible."). Because of the relaxed disclosure standard, plant patents (unlike utility patents) are typically very short documents, simply identifying the distinguishing characteristics and claiming the plant so identified, and the PTO does not require a deposit. *MPEP* § 2403.02.[9]

3. Plant Variety Protection Act of 1970: 7 U.S.C. §§ 2321-2582

The 91st Congress added yet another new protection for plants in 1970. This legislation followed a change in congressional understanding about the general ability of

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reproduce the plant." *See* Pet. Br. 18 n.6 (quoting Rev. Stat. § 4884); Pet. App. 42. But the 1930 committee reports state: a "plant patent covers only the exclusive right of asexual reproduction." 1930 Senate Report at 5; 1930 House Report at 6.

In 1995, the Federal Circuit held that plant patents were limited to the single distinguished individual and "its asexually reproduced progeny," basing that holding on its construction of Section 163 and Section 161, which, the court concluded, did not use "variety" to refer to a characteristic-defined *category* of plants (as does the Plant Variety Protection Act, discussed below). *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1567-68, 1569-70 (Fed. Cir. 1995).

[9] Section 161 does not identify non-obviousness as a requirement, and the 1930 committee reports furnish grounds to doubt that such a requirement was intended. *See* 1 D. Chisum, *Patents* § 1.05[1][b][vi]. Nevertheless, Section 161 has, since 1952, stated that Title 35 applies "except as otherwise provided," and one important Plant Patent Act decision has required non-obviousness. *See Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347, 1379 (5th Cir. 1976); *see also MPEP* § 1608.

sexual reproduction to breed plants "true to type." In 1930, the congressional committees had stated their understanding that only asexual propagation (maintaining genetic identity) reliably enough reproduced in progeny the characteristics making the plant variety distinctive. 1930 Senate Report at 4; 1930 House Report at 4-5. In 1968, a Senate subcommittee heard testimony that plant breeding techniques had developed so that sexual propagation now could, as a practical matter, reproduce distinguishing characteristics in plant populations.[10] *See Chakrabarty*, 447 U.S. at 313 (whereas 1930 Congress believed "new varieties could not be reproduced true-to-type through seedlings," "[b]y 1970, however, it was generally recognized that true-to-type reproduction was possible" through seed-based propagation).

The 91st Congress, in 1970, added new protection outside the Patent Act, enacting the Plant Variety Protection Act (PVPA), Pub. L. No. 91-577, 84 Stat. 1542, codified as amended at 7 U.S.C. §§ 2321-2582, to be administered by the Secretary of Agriculture. Under the PVPA, a certificate can

[10] *See Patent Law Revision*, Hearings before the Subcomm. on Patents, Trademarks, and Copyrights of the Senate Comm. On the Judiciary, 90th Cong., 2d Sess. 640 (1968) ["1968 Senate Hearings"] (While the "improvement of crop varieties through plant breeding . . . was still in its infancy" in 1930, it "has evolved as an industry largely since 1930. Improved breeding techniques and seed multiplication procedures have developed whereby the varietal identity of a sexually reproduced plant can be maintained intact over an extended period of time."); *id.* at 651 ("Improved and commonly known plant breeding techniques developed in recent years have provided numerous varieties of sexually reproduced plants which are also capable of reproducing true to form, so that the characteristics of the plant variety are maintained in the progeny."); *id.* at 655, 660-70, 748-51, 785. This evidence was accompanied by other testimony, including from the Secretary of Agriculture and Commissioner of Patents, expressing concern that variability remained significant and that, as a result, "the value of patents for sexually reproduced plants would be questionable, and their enforcement uncertain." *Id.* at 885; *see, e.g., id.* at 715-18, 799, 862-69, 873-76.

be issued for a broader class of newly developed plants than can qualify for patent protection. 1 D. Chisum, ***Patents*** § 1.05[2][a][i] ("The certification standards of the PVPA are less rigorous than the standards for utility, design and plant patents."). In the original Act, a certificate was available for any "novel variety of sexually reproduced plant (other than fungi, bacteria, or first generation hybrids)." Pub. L. No. 91-577, § 42(a), original 7 U.S.C. § 2402(a).[11] A "novel variety" was one with "distinctness" (it differs in *any* characteristic from plants previously known), "uniformity" across a population (any variations are "describable, predictable, and commercially acceptable"), and "stability" (its "essential and distinctive characteristics" are passed on to progeny "with a reasonable degree of reliability" when sexually reproduced). *Id.* § 41(a), original 7 U.S.C. § 2401(a). The PVPA has from 1970 defined sexual reproduction to be seed-based reproduction. *Id.* § 41(f), original 7 U.S.C. § 2401(b). No requirement of nonobviousness or utility or the kind of written description required by 35 U.S.C. § 112 has ever been part of the PVPA.

In 1994, the 103rd Congress further broadened the eligibility for PVPA protection, seeking (among other things) to conform to the International Convention for the Protection of New Varieties of Plants of 1991 (known as the "UPOV" convention, based on the French name). *See* H.R. Rep. 103-699 at 7 (1994). The basic standards of novelty, distinctness, uniformity, and stability remain, but the PVPA, while continuing to exclude fungi and bacteria, no longer excludes first-generation hybrids but now covers any sexually reproduced variety and, in addition, covers tuber propagated plant varieties—notably, potatoes. 7 U.S.C. § 2402.

[11] The 1970 Act also contained an exemption for "okra, celery, peppers, tomatoes, carrots, and cucumbers." Pub. L. No. 91-577, § 144, original 7 U.S.C. § 2583. The exemption was repealed by Pub. L. No. 96-574, § 20, 94 Stat. 3352.

"Variety" is now defined (in terms of any genetically based characteristics); "new" is used in place of the original "novel"; and rules governing determinations of priority are set forth. *See, e.g.*, 7 U.S.C. §§ 2401(a) & (b), 2402(a)(1) & (2), 2425. Although an applicant seeking a certificate (through what is mostly a fill-in-the-boxes enumeration of the distinguishing characteristics) must submit seeds of the variety (7 U.S.C. § 2422(4); 7 C.F.R. § 97.6), the more limited disclosure requirement has meant that the deposit is not accessible to the public (as petitioners do not deny, Pet. Br. 29-30 n.10).

For the wide range of certified plants, the PVPA provides, in general, a broad grant of exclusive rights and a related scope of protection. "Infringement" includes unauthorized reproducing, selling, offering for sale, importing, exporting, sexually multiplying for marketing, and using for "production" of a new variety. 7 U.S.C. §§ 2483 (grant), 2541 (infringement); *id.* § 2401(a)(3) (definition); *see* Pub. L. No. 91-577, §§ 83, 111.[12] Since 1994, the protection also has included certain actions going beyond the certificated variety itself, reaching, for example, a variety "essentially derived" from the certificated one. 7 U.S.C. §§ 2401(a)(3), 2541(c).

The infringement provision explicitly recognizes that the class of PVPA-covered plants includes plants that can qualify for a plant patent under 35 U.S.C. §§ 161-164 and that even asexual reproduction is generally a PVPA infringement. Section 2541, after listing various acts that constitute infringement, adds that it is also infringement for anyone without authority to do those acts "even in instances in which the variety is multiplied other than sexually, except in

[12] Like patents at the time, PVPA certificates originally lasted for 17 years from issue. Pub. L. No. 91-577, § 83(b), original 7 U.S.C. § 2483(b). The term was lengthened to 18 years in 1980. Pub. L. No. 96-574, § 14, 94 Stat. 3350. In 1994, the term was generally lengthened to 20 years (and 25 years for trees and vines). 7 U.S.C. § 2483(b).

pursuance of a valid United States plant patent." 7 U.S.C. § 2541(a)(9). That provision acknowledges that the same plant, being capable of both sexual and asexual reproduction, may qualify for both PVPA and plant-patent protection.[13]

The protections of the PVPA, though broad, are in some respects narrower than the protection for utility patents. For example, the certificate holder is not granted protection against others' use of the variety to "develop[]" (as opposed to "produce") a "hybrid or different variety therefrom." 7 U.S.C. §§ 2483(a)(1), 2541(a)(4); Pub. L. No. 91-577, §§ 83(a), 111(4), original 7 U.S.C. §§ 2483(a)(1), 2541(a)(4). Relatedly, use and reproduction of a certificated variety for "plant breeding or other bona fide research" is not infringement. 7 U.S.C. § 2544; Pub. L. No. 91-577, § 114, original 7 U.S.C. § 2544. In addition, unless sexual reproduction as a step in marketing is involved, or production of a hybrid or different variety is involved, farmers may "save seed" produced by plants grown from seed initially acquired for seeding purposes and use it to replant their own fields (or sell for non-reproduction purposes through usual channels).

[13] Whether the same plant could actually *obtain* both forms of protection is unclear, given that each grant would generally be prior art with respect to the other, so the real-world effect of the "except" clause as a "carve-out" from what is otherwise expressly defined as infringement (Pet. Br. 21) is unclear. *See* 1 D. Chisum, *Patents* § 1.05[2][d][i]. (The "except" clause was not in the original 1970 bills, *see Plant Variety Protection*, Hearing before the Subcomm. on Departmental Operations of the House Comm. on Agriculture, 91st Cong., 2d Sess. 102 (1970) ["1970 House Hearing"]; *Plant Variety Protection Act*, Hearing before the Subcomm. on Agricultural Research and General Legislation of the Senate Comm. on Agriculture and Forestry, 91st Cong., 2d Sess. 37 (1970) ["1970 Senate Hearing"]; the clause appeared in the legislation as reported from committee, *see* H.R. Rep. 91-1605 at 11 (1970) ["1970 House Report"]; S. Rep. 91-1138 at 12 (1970).) What is clear is the ability to qualify under both statutory regimes and the general PVPA protection against asexual as well as sexual reproduction.

7 U.S.C. § 2543; *see Asgrow Seed Co. v. Winterboer*, 513 U.S. 179 (1995). The original 1970 Act also allowed farmers to sell such saved seed to other farmers for replanting (Pub. L. No. 91-577, § 113, original 7 U.S.C. § 2543), but the 1994 Congress broadened the PVPA protection by deleting that exemption. *See* H.R. Rep. 103-349 at 11, 17-18 (1994). Finally, private, noncommercial performance of any otherwise-infringing activity is not infringement. 7 U.S.C. § 2541(e).

C. This Litigation

Respondent Pioneer (founded in 1926 by Henry A. Wallace, later Secretary of Agriculture and Vice-President) obtained various utility patents on hybrid and inbred lines of corn. Petitioners, without authorization, sold patented hybrid seed. The courts below rejected petitioners' invalidity argument that the patents claimed matter outside the coverage of Section 101.

1. Pioneer's Patents

In the early 1990s, Pioneer applied for various patents involving certain new varieties of corn (both hybrid and inbred), which, in ordinary commercial practice, is reproduced sexually—by planting seeds. Examples are reproduced at JA 28-39 (hybrid) and JA 40-50 (inbred), issued in 1996. The patents provide lengthy disclosures of the means of plant breeding, the specific features of the variety, and their useful characteristics compared with other varieties as measured in numerous important ways. JA 29-39, 41-50. They identify the American Type Culture Collection (ATCC) depository in Rockville, Maryland, where the public, without restrictions, has access to the samples deposited here. JA 39, 50.

The hybrid-line patent in the appendix claims the plant designated by the Pioneer name (3394) and ATCC deposit number and any plant "having all [its] physiological and

morphological characteristics," as well as certain "tissue culture[s] of regenerable cells" of the plant, a plant regenerated from such cells, and seed produced by the designated hybrid corn plant. JA 39. The inbred-line patent in the appendix claims the seed designated by the Pioneer name (PHP38) and ATCC number, "[a] corn plant produced by the seed," specifically "[a]n inbred corn plant having all the physiological and morphological characteristics" of such a plant, certain "tissue culture[s] of regenerable cells" of the plant, and a plant regenerated from such cells. JA 50. Although the claims have not been judicially construed, the specification of the inbred-line patent states that it "relates to," among other things, "hybrid corn seeds and plants produced by crossing the inbred line PHP38 with another corn line or a related species." JA 42. Petitioners, in their answer in this litigation, acknowledged that "[t]he patents that claim inbred corn lines as the invention alleged that the invention . . . relates to hybrid corn seeds and plants produced by crossing the particular inbred line with another corn line." JA 17; *see, e.g.*, U.S. Patent No. 5,689,034, col. 28 (claim 13).

2. District Court Proceedings

In 1998, Pioneer brought this action for patent infringement against petitioners. JA 6. The complaint lists 17 patents, identified as covering ten named hybrids and certain "associated" patents, some of them naming inbred lines (because inbred-line patents may cover hybrids produced from the named inbreds). JA 8-9; *see also* JA 27. The complaint alleged that Pioneer licensed the seeds "solely for use 'to produce grain and/or forage,'" not for any sale by the licensee. JA 10; *see* JA 51 (license on seed bag). The complaint asserted that petitioners are "infringing one or more" of the identified patents by "making, using, selling, or offering for sale corn seed of the above-referenced hybrids." JA 10.

Petitioners' answer, though generally denying infringement, did not deny that they were selling hybrid seed covered by Pioneer patents. JA 12-17. Instead, they stated a defense (and counterclaim) of patent invalidity, on a single ground: "corn (maize) plants are not patentable subject matter within the scope of 35 U.S.C. § 101." JA 14; *see* JA 17. Although petitioners stated a number of other defenses (false marking, failure to seek a PVPA certificate for the hybrid lines, acquiescence or laches, waiver, and estoppel), petitioners did not assert invalidity of the patents on any other ground—*e.g.*, novelty, utility, nonobviousness, adequate written description. JA 14-19.[14]

Petitioners moved for summary judgment on the Section 101 invalidity ground. The record on that motion included the several pre-1985 patents on plants or seeds that are in the appendix (JA 52-69), an affidavit reporting a database survey showing more than 1600 utility patents involving "plants" in their claims as of 1998 (JA 20-22), and evidence that petitioners did resell Pioneer seed despite the license restriction to using seed to produce grain or for forage (JA 23-26). The district court, noting the absence of any factual disputes, denied the motion (Pet. App. 13-39), conducting a detailed analysis to reject petitioners' contention that the

[14] Although petitioners seem to suggest that Pioneer's patents fail to make an adequate disclosure (Pet. Br. 29-30 n.10), they have not so alleged in this litigation. In any event, the only issue presented is validity under Section 101—which must be decided by assuming that all requirements for adequate disclosure will be duly enforced when properly raised. In the court of appeals, when petitioners "argue[d] that the specifications of Pioneer's patents are not enabling" and "criticize[d] the written description and the utility of the deposits," the court said: "These issues were not decided by the district court, and are not before us." Pet. App. 9.

Plant Patent Act and the PVPA "are the exclusive federal statutory mechanisms for plants covered by those acts." *Id.* at 23.[15]

The court observed that the broad language of Section 101, on its face and as construed by this Court in *Chakrabarty*, readily embraces plants (*id.* at 21-22) and that petitioners did not contend otherwise, but argued simply that the Plant Patent Act (PPA) and PVPA required a different conclusion. *Id.* at 22-23. Petitioners, however, did "not point to any specific language in the PPA or the PVPA" that "restrict[s] the scope of the patentable subject matter under § 101." *Id.* at 23. And the legislative histories of the relevant statutes made clear that, while committee reports may reflect a *belief* that utility patents were unavailable, "there is nothing in those legislative histories from which one could conclude that Congress intended to remove from the already in place protection of § 101 any subject matter already within the scope of that section." *Id.* at 28. The court noted, moreover, the statement from S. Rep. 91-1246 at 3 (1970) that the 1970 PVPA "does not alter protection currently available within the patent system" and the fact that some utility patents on plants were issued prior to 1970 "where inventors showed they could define a reproducible plant meeting" the description requirements of Section 112. *See* Pet. App. 28, 29 (citing Boehm patent, at JA 52). The court concluded: "In passing the PVPA and [Plant Patent Act], Congress maintained the broad language of § 101 in order to recognize, reward, and encourage developments in plant breeding that were capable of someday meeting the enablement requirements." Pet. App. 30.

[15] The inbred lines identified in the "Inbred Corn Line" patents are also the subject of PVPA certificates. Pet. Br. 5 (citing district court transcript).

The court next rejected petitioners' argument "that there has been an implicit repeal of a portion of 35 U.S.C. 101 because of an irreconcilable conflict" between utility patent coverage and the PVPA. Pet. App. 30. Citing the demanding standards applicable to such an argument, the court concluded that petitioners fell "far short of what would be required to find an irreconcilable conflict or positive repugnancy." *Id.* at 31-32. In particular, while the scope of protection is broader for utility patents, "the legal standards that must be satisfied to receive a utility patent"—*e.g.*, non-obviousness, the extent of the disclosure—are more stringent than for a PVPA certificate. *Id.* at 32-33. The court noted that the PTO, in its 1985 *Hibberd* decision, had likewise concluded that the different qualifications for coverage meant that there was no irreconcilable conflict between the statutory regimes giving different coverage. *Id.* at 34-35. Observing that Congress has not repudiated *In re Hibberd* even though it has amended the Patent Act numerous times since 1985 (*id.* at 36), and that *Chakrabarty* rejected the view of the Plant Patent Act and PVPA (similar to petitioners') set forth in Justice Brennan's dissent (*id.* at 37-39), the court concluded: "At no place in any of the statutes does it say that seed corn plants cannot be given a patent" or, indeed, that "you cannot have both patent and PVPA protection." *Id.* at 39.

3. Court of Appeals Decision

On an interlocutory appeal certified under 28 U.S.C. § 1292(b) (*see* Pet. App. 10-12), the court of appeals affirmed, substantially relying on the district court's analysis. Pet. App. 1-9. Noting the breadth of Section 101 as construed in *Chakrabarty*, the court observed that petitioners "do not dispute that the subject matter of the patents in suit is within the scope of the *Chakrabarty* decision." *Id.* at 4. The court explained that, while plants were once "deemed" unpatentable as "'products of nature'" and incapable of adequate description, the former objection had been invalid at

least since *Chakrabarty* and "precision of description is no longer an insurmountable obstacle, due both to rules authorizing the deposit of new species in publicly available depositories, and advances in botanical understanding and analysis." *Id.* at 5. "Although there remain the traditional categories that have never been viewed as patentable subject matter, *viz.*, laws of nature, natural phenomena, and abstract ideas, the policy underlying the patent system fosters its application to all areas of technology-based commerce." *Id.* at 5.

The court rejected petitioners' reliance on the PVPA to overcome Section 101. It explained that plants are not excluded from Section 101 just because "the PVPA Congress [may have] believed that seed-grown plants were not included in the patent statute (*id.* at 8) and that "the PVPA does not purport to remove plants from the patent statute" (*id.*). Moreover, "the asserted conflict" between patent coverage and PVPA coverage "is simply the difference in the rights and obligations imposed by the two statutes." *Id.* at 9. Thus, not having been cut back by another enactment, "patentable subject matter under 35 U.S.C. § 101 includes seeds and seed-grown plants." *Id.*

SUMMARY OF ARGUMENT

Diamond v. Chakrabarty, 447 U.S. 303 (1980), conclusively establishes that the "plain meaning" of the language enacted by Congress in 1793 and now in Section 101, which covers both "manufacture[s]" and "composition[s] of matter," embraces anything made with human intervention. 447 U.S. at 314-15. The plant life claimed in Pioneer's patents is squarely within that judicially declared plain meaning. To show that Section 101 is inapplicable, therefore, petitioners must demonstrate that Congress elsewhere has taken action that overrides the plain meaning of Section 101. Congress has not done so.

Neither the Plant Patent Act nor the PVPA alters Section 101. Likewise, their legislative histories evince no intent to limit the meaning of the terms "manufacture" and "composition of matter" to some particular view at some particular time. Whatever Members of Congress believed about the coverage of that language at any given time, no Congress has done anything to limit such coverage or even stated an intent to establish a limited scope to Section 101. In particular, when the 1930 Congress added the "plant" phrase to the existing terms, those terms already overlapped, and the patent law used no "definitions" to broaden the scope of statutory terms, so the addition of separate "plants" language in no way implied that the existing terms could not embrace plants. To the contrary, as *Chakrabarty* itself establishes, the congressional intent in 1930 was entirely in the direction of adding protection by *repudiating* the notion that patentable subject matter, as then understood, somehow excluded human-developed plant life. The 1970 Congress likewise only added coverage and said nothing to preclude giving Section 101 the plain meaning, embracing plant life, that this Court finally confirmed in *Chakrabarty*.

Petitioners' argument for limiting Section 101, therefore, must come down to establishing an actual conflict between its plain meaning and what Congress did in the PVPA or Plant Patent Act. Such a conflict was critical even in the authorities petitioners invoke, *United States v. Estate of Romani*, 523 U.S. 517 (1998), and *FDA v. Brown & Williamson Tobacco Corp.*, 120 S. Ct. 1291 (2000), and a still more demanding standard—the irreconcilable conflict required for an implied repeal—properly applies in this case, because the statutory meaning sought to be overriden here (unlike in petitioners' authorities) is both plain and already judicially declared. In any event, no inconsistency is present at all. Conferring somewhat lesser protections on a broader class of subject matter, including plants that do not meet the full

qualifications for utility patent protection, is consistent with conferring somewhat stronger protections for the narrower class that fully meets all such requirements.

In the years since *Hibberd*, not only has the industry relied on the availability of utility patents, but Congress itself has recognized and ratified, as consistent with its other enactments, the availability of utility patent protection for plants. The legislative history in the 103rd Congress, which enacted the comprehensive 1994 amendments to the PVPA, repeatedly recognizes the existence of utility patent protection for plants and not only fails to express a perception of inconsistency but explains the basis for consistency: the qualifications to obtain (weaker) PVPA protection are laxer than for (stronger) utility patent protection. And in 1999, Congress took affirmative action, by amending 35 U.S.C. § 119, to expand the rights of the holders of utility patents covering plants. The coverage of plants by Section 101, in sum, has been confirmed, rather than undermined, by subsequent congressional action.

ARGUMENT

The language of Section 101, as authoritatively construed in *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), covers the plant life claimed in the patents at issue. That coverage has not been curtailed by the other congressional enactments on which petitioners rely, which are not inconsistent with Section 101 coverage of plant life. This construction, moreover, has been ratified by Congress. Accordingly, as a matter of pure statutory construction—and in any event as a reasonable statutory construction by the several responsible federal agencies, which recognize, and have issued patents and PVPA certificates in recognition of, the consistency of the several statutory regimes (*see Christensen v. Harris County*, 529 U.S. 576 (2000) (multiple bases for deference); Pet. Br. 14 (discussing issue in context set by *Chevron*,

U.S.A., Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837 (1984))—Section 101's coverage of Pioneer's patents should be affirmed.

I. THE STATUTORY SUBJECT MATTER SET FORTH IN SECTION 101, AS THAT PROVISION WAS PROPERLY CONSTRUED IN *CHAKRABARTY*, COVERS PLANT LIFE

The 1793 Congress enacted, and Congress has since left in place, language (now in Section 101) that was intentionally broad, establishing a basic charter covering the full range of human-made inventions. This Court's decision in *Chakrabarty* definitively establishes the plain meaning of that language, which just as plainly embraces the subject matter at issue here: a plant bred by human effort is a "manufacture" or "composition of matter." 35 U.S.C. § 101. Petitioners present no serious argument to dispute the construction of the "manufacture [or] composition of matter" language or its application to plant life.

In *Chakrabarty*, holding that living microorganisms come within Section 101, this Court explained that the words of Section 101 must be given their ordinary meaning, not limited by restrictions that Congress has not expressed. 447 U.S. at 308. The Court reiterated the proper construction of "manufacture" "in accordance with its dictionary definition to mean 'the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.'" *Id.* (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)). The Court likewise reiterated the proper construction of "composition of matter" "consistent with its common usage to include all compositions of two or more substances . . . and all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids,

powders or solids." *Id.* (internal quotation marks omitted). The Court concluded that those "expansive terms" were plainly meant to "be given wide scope," citing legislative history from the 1952 recodification indicating "that Congress intended statutory subject matter to 'include anything under the sun that is made by man.'" *Id.* at 308-09 (quoting 1952 Senate Report at 5 and 1952 House Report at 6).

The Court noted that the field of human-made inventions had long been defined by reference to what it did not encompass—"laws of nature, physical phenomena, and abstract ideas," so that, in particular, "a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter." 447 U.S. at 309. But where human intervention has gone well beyond any "find" in nature, the invention is on the human-made side of the Section 101 line even though made of natural, indeed of living, matter (including microorganisms, which reproduce). *Id.* at 309-10. The Court further stressed the breadth of the plain meaning of "manufacture" and "composition of matter" by explaining that those terms were broad, *not* ambiguous (*id.* at 315),[16] and that such breadth of meaning was part of the very policy of patent law: to protect the unanticipated (*id.* at 315-16). Expressly rejecting the argument that a new congressional action should be required to address policy issues specific to the area before the plain meaning would

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[16] *See PGA TOUR, Inc. v. Martin*, No. 00-24, slip op. at 27 (May 29, 2001) ("'the fact that a statute can be applied in situations not expressly anticipated by Congress does not demonstrate ambiguity. It demonstrates breadth.'"), quoting *Pennsylvania Dept. of Corrections v. Yeskey*, 524 U.S. 206, 212 (1998); *Barr v. United States*, 324 U.S. 83, 90 (1945) ("if Congress had made a choice of language which fairly brings a given situation within a statute, it is unimportant that the particular application may not have been contemplated by the legislators") (citing *Browder v. United States*, 312 U.S. 335, 339 (1941), and *Puerto Rico v. Shell Co.*, 302 U.S. 253, 257 (1937)).

apply to living matter (*id.* at 316-17),[17] the Court concluded that Section 101 is an intentionally broad provision that, in accord with its terms' "plain meaning," embraces any human-made matter. *Id.* at 314, 315; *see Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 154 (1989) ("the potentially patentable includes 'anything under the sun that is made by man'") (quoting *Chakrabarty*, 447 U.S. at 309).[18]

Plant life like that claimed in Pioneer's patents clearly involves human-made technology within the plain, broad

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[17] This same argument is now made by petitioners (Pet. Br. 47-49) and their *amici* (American Corn Growers Ass'n *Amicus* Br. 13-30; Pollack *Amicus* Br. 2-14), as it can almost always be argued that one particular technology requires a different policy approach. But, as *Chakrabarty* establishes, Congress has already made the categorical judgment that innovation is best promoted by the private incentives created by the patent system, in all areas covered by Section 101's language. That judgment governs unless Congress changes it. Concerns about alleged undue concentration in a particular industry (raised by the American Corn Growers Association) raise an antitrust issue not relevant here.

We note that *amici*'s suggestion of higher seed prices (American Corn Growers Ass'n *Amicus* Br. 26) is deficient on its face. It does not control for inflation or for increased yield per acre—or, apparently, for increased amounts of seed used per acre.

[18] The Court in *Chakrabarty* declined to compartmentalize the terms of Section 101, holding instead that the living matter at issue came within the "manufacture [or] composition of matter" language of Section 101, without need to separate the categories or identify which term applied. The Court of Customs and Patent Appeals, in the decision affirmed by *Chakrabarty*, explained that the categories within Section 101 are *not* distinct. *In re Bergy*, 596 F.2d at 985 ("Chemical compounds . . . have unquestionably always been regarded as both 'manufactures' and 'compositions of matter' . . . ."); *id.* at 974 n.11 (quoting P.J. Frederico, principal drafter of the 1952 Act: "'"In the statute there is no basis for assuming that these [four terms—machine, manufacture, composition of matter, and process or art] represent four separate compartments of invention. Rather does the use of the four terms represent an effort to indicate the general industrial boundary of the single field of patentable invention." ' ").

meaning of Section 101 as confirmed by *Chakrabarty*. The 1930 congressional committees explained in clear terms that the human intervention required in developing and breeding new varieties of plants out of nature's material is no different in kind from the human intervention required in developing new chemicals out of nature's material. 1930 Senate Report at 7; 1930 House Report at 7-8. That elementary proposition is equally true whether the plant produced (commonly through time-consuming and labor-intensive sexual propagation by crossing and selection) is thereafter routinely propagated by asexual or sexual methods. The human intervention can be as substantial an undertaking as technological development in other fields. *See* 1994 House Report at 9 ("The development of new plant varieties is arduous, time-consuming, and costly. Many years must be spent in the development of a single new variety, with no guarantee of its success or profit."); *see id.* at 17-18 (same, quoting Department of Agriculture representative); Rossman, *Plant Patents*, 13 J.P.O. Soc'y 7, 10 (1931) ("It often takes from ten to fifteen years to perfect a new plant so that it can be placed on the market.").

Chakrabarty itself confirms that plants bred with human assistance are not on the "products of nature" side of the Section 101 line separating unpatentable from patentable subject matter. The Court explained that the 1930 congressional committees *rejected* "the belief that plants, even those artificially bred, were products of nature for purposes of the patent law" (447 U.S. at 311), and the Court noted that the committees "explained at length [their] belief that the work of the plant breeder 'in aid of nature' *was* patentable invention" (*id.* at 312 (emphasis added)). Immediately after quoting the 1930 committees' specific distinction between a merely found mineral and "'a plant discovery resulting from cultivation'" (*id.* at 313, quoting 1930 Senate Report at 6 and 1930 House Report at 7), the Court adopted what Congress "recognized [as] the relevant distinction"—"not between

living and inanimate things, but between products of nature, whether living or not, and human-made inventions." 447 U.S. at 313. Both Congress and this Court have thus made clear that plants are on the protectable side of that distinction.

Petitioners make essentially no attempt to deny that the language in Section 101, as enacted by Congress in 1793 and left in place since then, has properly been given its plain meaning to cover anything made by humans and that plant life is within that meaning. Petitioners' only real suggestion to the contrary (Pet. Br. 32-33) is their reliance on a footnote in *In re Bergy* stating that the authors of the "anything under the sun that is made by man" statement in 1952—which appeared in the 1952 committee reports and in earlier testimony by P.J. Federico, "a principal draftsman of the 1952 recodification" (*Chakrabarty*, 447 U.S. at 309 & n.6)—"realized that Congress did not intend the term 'manufacture' in § 101 to include plants." *In re Bergy*, 596 F.2d at 987 n.25. But that pre-*Chakrabarty* statement cannot conceivably override the plain meaning of Section 101 as authoritatively construed in *Chakrabarty*.

First, the statement is not, and does not quote or cite, anything said at the time of the 1952 Patent Act declaring an intent not to cover plants in Section 101; it is therefore not "legislative history" in the usual sense, *i.e.*, a contemporaneous internal statement about the meaning of language about to be adopted (the only statements that can inform any vote in Congress). After-the-fact attributions of intent by participants in the original proceedings (commonly Members or committees of Congress) have repeatedly been denied significance by this Court. *See Secretary of the Interior v. California*, 464 U.S. 312, 331 n.15 (1984); *Russello v. United States*, 464 U.S. 16, 26 (1983); *Railroad Reorganization Act Cases*, 419 U.S. 102, 132 (1974); *United States v. Price*, 361 U.S. 304, 313 (1960). Second, the *Bergy* footnote, by its terms, discusses only "manufacture"; it does not even address

"composition of matter"—and hence, taken at face value, does not limit Section 101's overall coverage. That limitation cannot be disregarded: the *Bergy* opinion carefully refers to *both* "manufacture" and "composition of matter" everywhere else it discusses the coverage of living matter by Section 101, including in the passages immediately before and immediately after the footnote. 596 F.2d at 975, 977, 978, 979, 985, 987.[19] Not surprisingly, then, the footnote finds no counterpart in this Court's decision in *Chakrabarty*, which stated the broad conclusion that Section 101 has a plain meaning that embraces any product produced through human intervention—a conclusion that embraces the plant life here.

II. CONGRESS DID NOT NEGATE SECTION 101'S COVERAGE IN EITHER THE PLANT PATENT ACT OR THE PLANT VARIETY PROTECTION ACT, BOTH OF WHICH ARE CONSISTENT WITH SECTION 101 COVERAGE OF PLANT LIFE

To overcome the straightforward application of the language of Section 101, as definitively construed in *Chakrabarty*, petitioners must identify some later enactment that requires modification of Section 101's coverage. Petitioners, however, cannot identify in any subsequent enactment, or its legislative history, an expression of intent to limit such coverage, so they must rest their case on an argument that the Plant Patent Act and the PVPA necessarily effected an implicit override of the naturally broad meaning of Section 101 as established by this Court in *Chakrabarty*. But there simply is no inconsistency between the enactments, and petitioners' effort to escape the judicially confirmed plain meaning of Section 101 must fail.

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[19] Judge Rich, the author of *Bergy*, later wrote the Federal Circuit's opinion in *Imazio* and there cited *In re Hibberd* without disapproval. *See* 69 F.3d at 1563.

A. Congress Has Not Acted Or Expressed An Intent To Limit Section 101

Although petitioners must overcome Section 101's plain meaning as confirmed in *Chakrabarty*, they cannot cite any act or statement establishing a congressional intent to alter Section 101's meaning. Most importantly, they do not and cannot point to any congressional modification of the language first enacted by Congress in 1793, which remains in place today. Nor do they, or can they, point to any statement in legislative history declaring an intent to alter the meaning accorded to Section 101's language by authoritative judicial construction (which did not occur until *Chakrabarty*). Similarly, petitioners do not and cannot point to any statement of congressional intent that Section 101 neither should nor could be construed to encompass plant life, allowing the award of utility patents for plants that can meet all of the Title 35 requirements.

Petitioners quote excerpts from the legislative history of the two acts they rely on, the Plant Patent Act and the PVPA (Pet. Br. 38-43), in an effort haltingly to suggest a congressional intent to modify Section 101. A simple reading of the quoted statements, however, establishes that the most they show is some *belief* on the part of some congressional committees that utility patent protection was not available at the time of the statements. "But unenacted . . . beliefs . . . are not laws . . . ." *Puerto Rico Dep't of Consumer Affairs v. ISLA Petroleum Corp.*, 485 U.S. 495, 501 (1988). Petitioners can quote no statement of a congressional intent to approve or prescribe any assumed narrow view of pre-existing law or to reject utility patent protection for those plants which can meet all requirements for such protection. *See* Pet. App. 23 (district court opinion). To the contrary, the intent reflected in each of the two statutes relied on by petitioners is, if anything, virtually the opposite of a repudiation of utility patent protection for plants that can qualify for that protection.

That intent is particularly clear in the Plant Patent Act, which added protection for newly developed plants that have been asexually reproduced. *Chakrabarty* explains that, when Congress was informed that plants were "thought"—though never authoritatively held—to be unprotected under the existing patent laws (447 U.S. at 311), the congressional committees pointedly *rejected* the only cited reasons relating to the scope of patentable subject matter, *i.e.*, that plants were not inanimate matter and were thought "products of nature." *See* 447 U.S. at 312-13. The natural means Congress chose to enact that conclusion into law, *i.e.*, addition of new "plant" language to the existing statutory terms, did not remotely imply (contrary to what its committee reports said) that plants were *outside* existing patentable subject matter. After all, the existing terms already overlapped (*see* note 18, *supra*); and the alternative means of broadening terms' scope—writing statutory definitions—was not then used in the patent law (*see* Rev. Stat. §§ 4883-4936; 35 U.S.C. §§ 1-88 (1926 ed.)).[20] Congress reinforced its judgment about patentability, moreover, by removing the only other cited impediment to patent protection for plants—the perceived difficulty of meeting the standards for an adequate description (*Chakrabarty*, 447 U.S. at 311-12; 1930 Senate Report at 9-10; 1930 House Report at 10; 1930 House Hearing at 7)—specifically to try to put agriculture on a practical par with other industry. *See* 1930 Senate Report at 1; 1930 House Report at 1; Pet. Br. 38. The congressional judgment in 1930 thus suggests approval, not rejection, of plants' coverage by the language now in Section 101.

Nor can any intent to preclude utility patent protection for plants that typically propagate sexually be inferred from

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[20] The means Congress chose also cautiously preserved severability in the face of any remaining constitutional questions about protecting "discoveries," as suggested by the PTO Commissioner. 1930 House Hearing at 6.

Congress's exclusion (*see* note 8, *supra*) of sexual reproduction from the Plant Patent Act. For one thing, petitioners themselves recognize that an even more express "exclusion" from the later PVPA—which excludes "bacteria" (7 U.S.C. § 2402(a))—creates no such implication; to the contrary, petitioners affirmatively rely on the fact that bacteria are "specifically excluded from coverage within the PVPA" to explain *Chakrabarty*'s square holding that Section 101 covers, rather than excludes, a bacterium. Pet. Br. 31. In any event, the legislative history records the reason for not covering sexual reproduction within the 1930 Act, a reason independent of any congressional intent to curtail coverage under Section 101. The 1930 congressional committees stated that sexual reproduction could not reliably enough maintain a plant's identifying characteristics (while in some instances it might do so). 1930 Senate Report at 4 (recognizing "practical situation" that seed-based reproduction generally does not reproduce "true to the type," stating categorical limit to asexual reproduction "irrespective of the degree to which the seedlings come true to type" in particular instance); 1930 House Report at 4-5 (same). Congress added protection in 1970 after it determined that its practical premise was no longer sound. *See Chakrabarty*, 447 U.S. at 313.

The enactment of the PVPA in 1970 to embrace sexual reproduction, like the 1930 enactment of the Plant Patent Act, reflects no intent to preclude utility-patent protection for plants that come within Section 101's language and meet all the other requirements for protection. The PVPA itself says nothing to modify Section 101. Nor do the 1970 committee reports, which are less informative than the 1930 committee reports. *See* 1970 House Report; S. Rep. 91-1246 (1970); S. Rep. 91-1138 (1970). The reports contain no statement indicating an intent in the PVPA to enact a limitation on Section 101, or to prescribe or approve a narrow under-

standing; there is, to the contrary, a statement that the new law "does *not alter* protection currently available within the patent system." S. Rep. 91-1246 at 3 (emphasis added); Pet. Br. 41.

Petitioners' *amici* (though not petitioners, *see* Pet. Br. 38-39) argue that "Congress" "rejected" the application of Section 101 to plants (American Corn Growers Ass'n *Amicus* Brief at 8), but that argument is wrong. Even in the authorities on which petitioners principally rely, *FDA v. Brown & Williamson Tobacco Corp.*, 120 S. Ct. 1291 (2000), and *United States v. Estate of Romani*, 523 U.S. 517 (1998), the Court, reflecting the constitutional method of writing laws, strongly rejected reliance on Congress's failure to take action. *See id.* at 533-34; *id.* at 535-36 (Scalia, J., concurring in part and concurring in the judgment) (more sweeping and categorical rejection of argument); *Brown & Williamson*, 120 S. Ct. at 1312 ("We *do not rely* on Congress' failure to act—its consideration and rejection of bills that would have given the FDA this authority—in reaching this conclusion." (emphasis added)). And this case provides no basis for any exception, for there was no "congressional" "rejection" of the statutory construction at issue, namely, Section 101 coverage of plants.

What *amici* invoke is not an act of the Congress that enacted the language at issue or an act by any Congress at all; they do not even rely on an act of a congressional committee or, apparently, an affirmative act even of a congressional subcommittee. In addition, the subject of the supposed "rejection" was, in fact, not Section 101 coverage of plants at all. What *amici* rely on was a proposal to extend Sections 161 and 163 to sexually reproduced plants (*see* 1968 Senate Hearing at 639, 715; American Corn Growers Ass'n *Amicus* Brief at 7) and the failure of that proposal to emerge from a Senate subcommittee in 1968. All that occurred was that "[o]bjections were raised and no action was taken" on the

proposal in 1968, as petitioners observed in the court of appeals (C.A. Brief for Appellants at 7). Thus, the Senate Judiciary Committee (whose subcommittee had conducted the 1968 hearings) noted in reporting the PVPA in 1970 (S. Rep. No. 91-1246, at 3): "A number of objections to this proposal were advanced during the hearings, and no further action in that area [was] taken by the subcommittee."[21] In fact, the sole reason stated by the subcommittee chairman for the subcommittee's inaction was merely one of "feasability," not a repudiation of utility-patent protection where all the practical requirements of Title 35 can be met.[22] The 1968 events, in short, "provide no support for the hypothesis that both Houses of Congress silently endorsed [the] position" petitioners and their *amici* urge, *i.e.*, that utility patents under Section 101 should not be available. *Estate of Romani*, 523 U.S. at 534.

Even if the focus were to broaden from any particular Congress to the overall pattern of actions by "Congress" over time, petitioners could not establish an intent to curtail utility-patent protection for those plant inventions meeting all the statutory requirements. To the contrary, petitioners' position would turn on its head the course of congressional action. Protection was added in the 1930 Plant Patent Act, expanded

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[21] The subcommittee hearings in 1968 also report a proposal by a presidential commission—which apparently had "no representative from the plant or agricultural industry"—to delete the plant patent provisions. 1968 Senate Hearings at 648-49; *see* Pet. Br. 39. The same presidential commission also recommended deletion of the design-patent provisions (35 U.S.C. §§ 171-173) and foreclosure of patent protection for computer programs, whether claimed as articles, as processes performed by a machine, or as machine configurations. *"To Promote the Progress of . . . Useful Arts,"* Report of the President's Commission on the Patent System 12 (1966). None of those proposals has been adopted by Congress.

[22] "'A significant difference of opinion exists as to the feasibility of accomplishing this objective through the plant patent statute.'" Quoted in 1970 House Hearing at 10; 1970 Senate Hearing at 55-56.

in 1954, and expanded again in 1998. *See* pages 7-9, *supra*. Protection was added in the 1970 Plant Variety Protection Act, expanded in 1980, and expanded again in 1994 (the last time, as noted below, with the expressed recognition that utility patent protection was by then available). *See* pages 9-14, *supra*. With respect to commercial exploitation, Congress's intent and actions were consistently to add protection—even for plants not able to meet all the requirements for utility-patent protection.[23] That pattern reinforces the absence of any evident intent to reject utility-patent protection for the narrower class of plant inventions meeting the more demanding standards for such protection.

Even if there were some legislative-history statement of intent to limit Section 101's coverage, such a statement would not, standing alone, suffice to overcome the judicially declared clear meaning of Section 101. It is fundamental that "[w]ithout a text that can, in light of those statements, plausibly be interpreted as *prescribing*" the curtailment of Section 101's meaning, "it is impossible to find" such a curtailment. *Puerto Rico Dep't of Consumer Affairs v. ISLA Petroleum Corp.*, 485 U.S. at 501; *see Mackey v. Lanier Collection Agency*, 486 U.S. 825, 839-40 (1988) ("the opinion of this later Congress as to the meaning of a law enacted 10 years earlier does not control the issue"; "these views—absent an amendment to the original language of the section—do not direct our resolution" of the construction of the original language). Petitioners must, therefore, identify a later enactment that is actually inconsistent with Section 101 coverage to support a judicial curtailment of the reach of Section 101.

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[23] With respect to *noncommercial* exploitation, *see* 7 U.S.C. § 2541(e) and 5 D. Chisum, *Patents* § 16.03 (possible "experimental use" exception to patent infringement).

B. There Is No Inconsistency With Subsequent Enactments That Can Support Curtailment Of Section 101

Although petitioners rely on *Chakrabarty*'s statement that Congress "may choose to craft a statute specifically designed for such living things" (447 U.S. at 318, quoted at Pet. Br. 31), that statement does not suggest that *any* such statute would negate Section 101's application; the Court said nothing to repudiate the usual standards for determining when a later enactment has altered the effect of an earlier one. Accordingly, petitioners turn to those standards, focusing their argument on the need to establish an actual inconsistency between Section 101 coverage of plants and Congress's enactments covering certain classes of plants in the Plant Patent Act and the PVPA. Pet. Br. 13-28. But petitioners' argument invokes inapplicable authorities and in any event fails even under those authorities.

Petitioners' predominant reliance on *Estate of Romani* and *Brown & Williamson*, *see* Pet. Br. 13-17, fails for two basic reasons. First, this case, unlike those, involves an effort to use later congressional enactments to reject a meaning of an earlier statute that is (a) plain and (b) already judicially established—making this case one where petitioners must meet the very demanding standards of implied repeal, as the district court concluded. Pet. App. 30 (describing the argument as one of "implicit repeal" requiring showing of "irreconcilable conflict"). Second, and in any event, even under *Estate of Romani* and *Brown & Williamson*, let alone under the implied-repeal decisions, petitioners cannot succeed, for there simply is no inconsistency between the statutes at issue here.

1. In both *Estate of Romani* and *Brown & Williamson*, the Court adopted a narrow meaning of an earlier statute based on later congressional enactments. The Court did not follow the implied-repeal approach, since, in both cases, no

judicially established broader meaning of the earlier statute had to be curtailed (indeed, any such broader meaning, for reasons of language or history, was dubious). Even without applying the standards for implied repeals, moreover, the Court adopted the narrow meaning of the earlier statute only in the face of later enactments that, the Court stressed, were in actual and clear conflict with the asserted broad meaning of the earlier statute.

In *Estate of Romani*, the Court held that an unperfected United States tax lien was denied priority over perfected judgment liens against an estate by the Tax Lien Act of 1966, which declares that an unperfected federal tax lien "shall not be valid as against any . . . judgment lien creditor" (*see* 523 U.S. at 521 & n.3), notwithstanding the earlier-enacted federal priority statute, which states that "[a] claim of the United States Government shall be paid first" when a decedent's estate cannot satisfy all claims (*see id.* at 519 & n.1). The Court not only explained the strong reasons why coverage by the priority statute was itself dubious (*id.* at 525-29) but stressed that "the question whether it has any application to antecedent perfected liens has never been answered definitively." *Id.* at 529. It was precisely because "this basic question of interpretation remains unresolved," the Court concluded, that the question to be answered was not whether "the Tax Lien Act of 1966 has implicitly amended or repealed the priority statute." *Id.* at 530. With no need to find an implied repeal, control by the Tax Lien Act was determined by the flat conflict between its command and the never-before-adopted construction of the older federal priority statute the Government urged. The Court noted that "it is agreed that by the terms of [the Tax Lien Act], the Federal Government's liens are not valid as against the lien" held by the judgment creditor (*id.* at 524), and it repeatedly made clear (as is evident from the statutory language) that the case was one of actual conflict of a proposed reading of an

earlier statute and the express command of the later statutes. *Id.* at 532-33 (case involved "conflict" and "'plain inconsistency'"); *id.* at 534 (case would involve "conflicting statutory provisions" on United States's reading of priority statute).

In *FDA v. Brown & Williamson*, the Court likewise faced a question of first impression, deciding that the Food Drug and Cosmetics Act (the FDCA) does not apply to tobacco products. 120 S. Ct. at 1297. With no previous construction of the FDA statute having to be overcome, and with reason to question the FDCA's coverage of tobacco as an initial matter (*id.* at 1300 ("intended" issue), 1308 (doubts about intent of 1938 Congress)), the Court invoked *Estate of Romani* to examine the effect of the subsequent tobacco legislation on a proper construction of the FDCA. *Id.* at 1301. That effect was held determinative, because in the later enactments "Congress has clearly precluded" application of the FDCA to tobacco. *Id.* at 1297; *id.* at 1306 ("Congress intended to exclude tobacco products from the FDA's jurisdiction").

The Court rested that conclusion on its determination of a clear inconsistency between the later express congressional prescriptions, in statutory text, and the application of the FDCA to tobacco. The Court explained that the FDCA would require an outright ban on tobacco products if it applied (*id.* at 1301-03) and that, in any event, "[t]he regulation of product labeling . . . is an integral aspect of the FDCA" (*id.* at 1309). Yet Congress, in other enactments, had "foreclosed the removal of tobacco products from the market" (*id.* at 1303) by declaring it important to preserve the tobacco market as long as health risks were disclosed (*id.* at 1303-04); and Congress had also specifically precluded any agency regulation of cigarette labeling and any agency "policy-making authority on the subject of smoking and health" (*id.* at 1309). These later enactments were, in multiple ways, simply

"incompatible" with what the FDCA would require if it applied. *Id.* at 1309, 1313, 1314.[24]

As *Estate of Romani* indicates, the more demanding "implied repeal" standards apply when later statutes are invoked to alter a meaning that has already been judicially declared. "The rarity with which [the Court has] discovered implied repeals is due to the relatively stringent standard for such findings, namely, that there be an irreconcilable conflict between the two federal statutes at issue." *Matsushita Elec. Indus. Co., Ltd. v. Epstein*, 516 U.S. 367, 381 (1996) (internal quotations omitted) (citing *Kremer v. Chemical Constr. Corp.*, 456 U.S. 461, 468 (1982); *Radzanower v. Touche Ross & Co.*, 426 U.S. 148, 154 (1976)); *see Connecticut Nat. Bank v. Germain*, 503 U.S. 249, 253 (1992) (Court must respect both of overlapping statutes unless there is "'positive repugnancy'" between them) (quoting *Wood v. United States*, 16 Pet. (41 U.S.) 342, 363 (1842)); *Morton v. Mancari*, 417 U.S. 535, 551 (1974) ("when two statutes are capable of coexistence, it is the duty of the courts, absent a clearly expressed congressional intention to the contrary, to regard each as effective"); *United States v. Borden Co.*, 308 U.S. 188, 198 (1939) ("[R]epeals by implication are not favored. When there are two acts upon the same subject, the rule is to give effect to both if possible.").

2. Petitioners are wrong in invoking *Estate of Romani* and *Brown & Williamson* to escape the implied-repeal standards. Petitioners are relying on later statutes to override a "plain meaning" of a statute that has already been judicially

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[24] In *United States v. Fausto*, 484 U.S. 439 (1988), the initial statute at issue, the Back Pay Act, actually made express reference to other laws, referring to certain determinations (about whether a Government personnel action was proper) by an "appropriate authority under applicable law." *See id.* at 454. The Court simply held that, when the other relevant laws changed, the "appropriate authority" for making the determination, by the very terms of the Back Pay Act, also changed. *Id.*

declared. *Chakrabarty*, 447 U.S. at 314. In this case, therefore, petitioners have to meet the high standards of the rule against implied repeal, requiring respect for both statutes unless there is an irreconcilable conflict. But there is no such irreconcilable conflict in this case.

That is so, indeed, for the same reason that there is not even a statutory inconsistency such as, in both *Estate of Romani* and *Brown & Williamson*, was critical to establishing that a later Congress had "precluded" a particular application of an earlier statute, as petitioners mistakenly say Congress has done here. Pet. Br. 13. In both the Plant Patent Act and the PVPA, Congress afforded certain defined protections for classes of plants that did not have to meet all the qualifications for utility patent protection. In particular, neither the Plant Patent Act nor the PVPA requires the inventor to make the full disclosure required by 35 U.S.C. § 112, now typically requiring a deposit of biological materals, with full public access to the deposit. And the PVPA does not require the showing of nonobviousness required for a utility patent, a showing made by the kind of extensive recitations that appear in Pioneer's patents (JA 29-50).[25] Those simple facts explain why petitioners' enumeration of various limitations on the protection afforded under the PVPA (Pet. Br. 22-24) cannot establish any inconsistency with utility-patent protection. Affording somewhat more limited protections to a wider class of subject matter, including plants whose inventors either could not meet or choose not to meet the full requirements for utility-patent protections, is consistent with affording stronger

[25] We note that, for both of the Pioneer patents that appear in the joint appendix, the file histories (which are not in the record of this case, but are public documents available from the PTO) show multiple rejections under both Section 103 (obviousness) and Section 112 (description). *See Ex Parte C*, 27 USPQ2d 1492, 1496 (Bd. Pat. App. & Interf. 1993) (rejecting application for utility patent on plant as obvious).

protections to the narrower class of subject matter that can meet the higher standards for obtaining a valid utility patent, precisely as the district court explained (Pet. App. 32-33).[26]

3. Not able to demonstrate actual inconsistency, petitioners resort to a suggestion (Pet. Br. 44-48) that mere overlap of the statutory enactments is enough to limit Section 101's plain meaning. The law is to the contrary. As the Court summarized it in *Borden*, 308 U.S. at 198: "It is not sufficient . . . 'to establish that subsequent laws cover some or even all of the cases provided for by [the prior act]; for they may be merely affirmative, or cumulative, or auxiliary.' ") (quoting *Wood*, 16 Pet. (41 U.S.) at 363). More recently, in *Mackey v. Lanier Collection Agency*, 486 U.S. at 839 n.14, the Court stressed the important difference between analyzing the effect of a later enacted statute on an earlier one and analyzing the effect of two simultaneously enacted provisions, explaining that overlap had significance only in the latter situation: "It is this sort of redundancy—i.e., the suggestion that Congress intentionally adopted, at a single time, two separate provisions having the same meaning—that calls a particular statutory interpretation into question." Overlap in laws enacted by different Congresses is no reason, in the absence of inconsistency, to decline to give effect to each statute, particularly where one has a judicially declared plain meaning; "[r]edundancies across statutes are not unusual events in drafting." *Connecticut Nat. Bank v.*

[26] Nothing about the administrative structure of the PVPA is inconsistent with PTO issuance of patents. Two Executive Branch departments have been assigned related but different responsibilities for judging certain applications. Expertise can and does reside in each department. Nor does Congress's creation of the PVP Board (7 U.S.C. § 2327), which serves merely in an advisory function (*id.* § 2327(b)), imply anything to negate the appropriateness of PTO examination and issuance of patent applications on plants.

Germain, 503 U.S. at 253; *see Merrill v. Fahs*, 324 U.S. 308, 312 (1945) ("explicitness was one of cautious redundancy").

In the present context it is particularly improper to infer from overlap of subject matter a congressional intent to achieve mutual exclusivity. The very statutes at issue preclude any inference that Congress intended to repudiate statutory overlap: as explained above, it is plain on the face of the PVPA, in 7 U.S.C. § 2541(a)(9), that Congress contemplated that the very same subject matter could be protected under either the PVPA or the Plant Patent Act. *See* pages 12-13, *supra*. More generally in the area of intellectual property rights, there is no general congressional antipathy to overlapping federal statutory protection.[27] It is well established, for example, that the very same ornamental design may be subject to protection against unauthorized use under a design patent (35 U.S.C. §§ 171-173), by copyright (17 U.S.C. §§ 101, 102(a)), and as a trademark (15 U.S.C. §§ 1052, 1125, 1127). *See Mazer v. Stein*, 347 U.S. 201, 217-18 (1954) (design patent and copyright); *In re Mogen David Wine Corp.*, 328 F.2d 925 (CCPA 1964); *MPEP* § 1512 ("an area of overlap between copyright and design patent statutes where the author/inventor can secure both a copyright and a design patent"; "[a] design patent and a trademark may be obtained on the same subject matter"); 1 D. Chisum, *Patents* § 1.04[5], [6].

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[27] In other areas, too, overlapping protections in federal statutory law are common. An employee may be protected against race discrimination by, for example, Titles VI and VII of the Civil Rights Act of 1964, 42 U.S.C. § 2000d *et seq.* and § 2000e *et seq.*, as well as 42 U.S.C. § 1981 and § 1983. An employee may be protected against sex discrimination by, for example, Titles VII of the Civil Rights Act of 1964, 42 U.S.C. § 2000e *et seq.*, and Title IX of the Education Amendments of 1972, 20 U.S.C. § 1681 *et seq.*, as well as the Equal Pay Act, 29 U.S.C. § 206. A user of public accommodations may be protected against disability discrimination by, for example, the Rehabilitation Act of 1974, 29 U.S.C. § 794, and by the Americans with Disabilities Act, 42 U.S.C. § 12101 *et seq.*

Contrary to petitioners' contention (Pet. Br. 46-47), no rule against overlapping protection was established or suggested by this Court's recent decision in *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 121 S. Ct. 1255 (2001). The Court there relied on a tension between the elements of two specific forms of protection, holding that the plaintiff's utility patent on a useful article created a strong presumption against satisfaction of the element of non-functionality required for trade-dress protection. That result does not speak to a situation, like the present, where satisfying the requirements for one form of protection does not even begin to imply inability to satisfy the requirements of another form of protection.

III. CONGRESS HAS RECOGNIZED AND RATIFIED THE AVAILABILITY OF UTILITY PATENT PROTECTION FOR PLANTS AND SEEDS ALSO COVERED BY THE PVPA

After the PTO's 1985 decision in *In re Hibberd*, the industry began relying on utility-patent protection. Within a few years, committees within Congress were informed of the general availability of utility patents on plants. In 1989, the Office of Technology Assessment submitted a report, requested by a congressional committee, entitled *New Developments in Biotechnology: Patenting Life*. Chapter 5 of the report, "Intellectual Property and Plants," extensively laid out the history and scope of coverage of plants by plant patents, utility patents, and PVPA certificates. *Id.* at 67-90.

Several years later, when the 103rd Congress considered and enacted its comprehensive amendments to the PVPA, the availability of utility patent protection was repeatedly recognized—without indication of any perception of inconsistency between utility patent coverage and PVPA coverage. Senator Kerrey, in introducing the amendments (139 Cong. Rec. S10867 (1993)), expressly recognized that

"utility patents," along with "plant patents" and "plant variety protection," were now available for plants. *Id.*; *see id.* at S10868 ("utility patents"). The same recognition was expressed by Senator Kerrey and others in the Senate hearings on the amendments. (*See Plant Variety Protection Act Amendments of 1993*, Hearing before the Subcomm. on Agriculture Research, Conservation, Forestry, and General Legislation of the Senate Comm. on Agriculture, Nutrition, and Forestry, 103d Cong. 1st Sess.2 (1993) ["1993 Senate Hearing"] ("utility patents"), 30 ("utility patents"), 31 ("utility patents"); *id.* at 33 ("utility patents"), 36 ("utility patents"))[28] and in the House hearings the next spring (*see Plant Variety Protection Act Amendments of 1993*, Hearing before the Subcomm. on Department Operations and Nutrition of the House Comm. on Agriculture, 103d Cong., 2d Sess.96 (1194) [1994 House Hearing"] ("utility patents"); *id.* at 97 ("utility patents"), 99 ("utility patents"), 102 ("utility patents")). *See also* 1993 Senate Hearing at 7 (statement from Department of Agriculture: "*one* effective form of protection for new plant varieties that are reproduced by seed is the [PVPA]") (emphasis added); 1994 House Hearing at 26, 63 (same).

Neither the Senate sponsor nor others expressed a view that the PVPA was somehow inconsistent with the availability of utility patent protection, though the reach of the protections differed. To the contrary, Senator Kerrey expressed the simple reasons why there was no inconsistency. He noted, in particular, that utility patents were available for a narrower class of plants than PVPA certificates, stating that "[t]he legal standards for protection are less stringent" under the PVPA and explaining:

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[28] The Committee also put questions to the Department of Agriculture based on the 1989 report of the Office of Technology Assessment, *Patenting Life*, which described the availability of utility patents for plants since 1985. *See* 1993 Senate Hearing at 89, 98.

> Eligibility for protection under the current PVPA requires that varieties be novel, distinct, uniform, and stable. The unobvious requirement of patent law, considered a more difficult hurdle, is supplanted by PVPA by distinctiveness—a requirement that the variety may be unique in one or more identifiable morphological, physiological, or other characteristics. Therefore, an obvious, but distinct, new variety, may be more easily protected under PVPA.

139 Cong. Rec. S10868 (1993) (Sen. Kerrey); *see* 1993 Senate Hearing at 3 (Sen. Kerrey). In short, there is no inconsistency between utility patent protection for the narrower class of plants qualifying for it (and for which the greater effort required to obtain utility patents is worthwhile) and the somewhat narrower protection for the broader class of plants qualifying (more easily) under the PVPA. *See also Patenting Life* at 76-77 (utility patents offer broader protection but are perceived as harder to obtain; utility patents, unlike PVPA certificates, also often require a deposit that is then publicly accessible).

The recognition of the availability of utility patent protection was written into the Patent Act in 1999. This Court has made clear that a legal understanding that recognizes the availability of certain rights can be ratified by a positive congressional enactment that extends an aspect of such rights. *See Alexander v. Sandoval*, 121 S. Ct. 1511, 1516 (2001); *Franklin v. Gwinnett County Public Schools*, 503 U.S. 60, 72 (1992); *id.* at 78 (Scalia, J., concurring in the judgment). Congress's 1999 amendment of 35 U.S.C. § 119 is precisely such an enactment.

For purposes of applying the various rules governing priority of invention, the filing date of a patent application is generally a critical date. *See* 35 U.S.C. § 102. Section 119 addresses the determination of the priority date when applicants for United States patents also have filed patent

applications for the same invention in foreign countries, providing for certain coordination during a one-year period. Specifically, Section 119 provides that, with certain exceptions, a United States patent application is treated as if it had been filed on the date of an application filed for the same invention (with adequate disclosure) within the previous twelve months in a foreign country affording reciprocal treatment of United States applications. *See* 35 U.S.C. § 119(a).

In 1999, Congress amended Section 119 by adding subsection (f), along with definitions in subsection (g). Pub. L. No. 106-113, Div. B, § 1000(a)(9), 113 Stat. 1536 (Nov. 29, 1999), enacting S. 1948, attached as Appendix I, § 4802, 113 Stat. 1501A-589. The new subsection (f) was added to include within the priority-date relief of Section 119 not only foreign applications for "patents" but also applications "for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party)." 35 U.S.C. § 119(f). That provision ratifies the availability of patent rights for plants covered by such "plant breeder's rights"—the term used under the UPOV Convention to describe the patent-like rights in plants (no matter which method of reproduction is typically used). The relevant conference report expressly states that this extension of patent rights covers not only "plant patent" protection but also "utility patent protection":

> Section 4802 also adds subsection (f) to section 119 of the Patent Act to provide for the right of priority in the United States on the basis of an application for a plant breeder's right first filed in a WTO member country or in a UPOV Contracting Party. Many foreign countries provide only a sui generis system of protection for plant varieties. Because section 119 presently addresses only patents and inventors' certificates, applicants from those countries are technically unable to base a priority claim on a foreign application for a plant breeder's right *when seeking plant patent or utility patent protection for a plant variety* in this country.

H.R. Conf. Rep. 106-464, at 328 (1999) (emphasis added) (footnote omitted); *see also* 145 Cong. Rec. S14696-03, S14723 (1999) (identical quotation from explanatory statement introducing S. 1948).

Petitioners, in discussing Section 119, do not deny that new Section 119(f) applies to utility patents on plants, including sexually reproduced plants. Instead, they say only that the enactment somehow cannot be given weight because it was "[a]n isolated amendment tacked on the end of a lengthy, multi-subject revenue bill." Pet. Br. 26; *id.* at 26-27. Even aside from the absence of cited authority establishing that parts of appropriations bills may be ignored, petitioners' characterization of the amendment at issue here is simply wrong.

The statute at issue, Pub. L. No. 106-113, enacted an appropriations bill, H.R. 3194, as set forth in H.R. Conf. Rep. 106-479 (1999), but Division B of that bill simply attached (among other things) what had been S.1948. *Id.* at 79. That bill, in turn, was identical to, and introduced simply to provide a vehicle for quick Senate adoption of, the conference bill, H.R. 1554, which had already passed the House as a separate substantive law. 145 Cong. Rec. H11826 (1999) (House approval of H.R. 1554 conference bill). *Compare* H.R. Conf. Rep. 106-464, at 181-82 (section 4802 of H.R. 1554) *with* H.R. Conf. Rep. 106-479, at 2408-09, and 145 Cong. Rec. H12230-02, H12605 (1999) (section 4802 of S. 1948). The explanatory statement accompanying S. 1948 (145 Cong. Rec. S14696-03, S14723 (1999)) is thus identical to the conference report on H.R. 1554 (H.R. Conf. Rep. 106-464, at 328). The appropriations bill was, accordingly, a procedural vehicle for enactment of a separately considered substantive bill.

Indeed, these bills in late 1999 were anything but novel in their proposal to add Section 119 protection based on breeder's right certificates for applicants for United States "utility patents." Prior congressional committees considering the same amendments to Section 119 had given the same explanations. *E.g.*, H.R. Rep. 106-287, Pt. 1, at 185 (1999) (proposing same amendment to section 119, explaining: "Because § 119 presently addresses only patents and inventors' certificates, applicants from those countries are technically unable to base a priority claim on a foreign application for a plant breeder's right when seeking plant patent or utility protection for a plant variety in this country."); S. Rep. 105-42, at 284-85 (1997) (proposing same amendment to Section 119, explaining: "Because section 119 presently addresses only patents and inventors' certificates, applicants from those countries are technically unable to base a priority claim on a foreign application for a plant breeder's right when seeking plant patent or utility protection for a plant variety in this country."); H.R. Rep. 105-39, at 218-19 (1997) (proposing same amendment to Section 119, explaining: "Because section 119 presently addresses only patents and inventors' certificates, applicants from those countries are technically unable to base a priority claim on a foreign application for a plant breeder's right when seeking plant patent or utility protection for a plant variety in this country."); H.R. Rep. 104-784, at 219-20 (1996) (proposing same amendment to Section 119, explaining: "Because section 119 presently addresses only patents and inventors' certificates, applicants from those countries are technically unable to base a priority claim on a foreign application for a plant breeder's right when seeking plant patent or utility protection for a plant variety in this country."). In brief, Congress has now passed a law approving the availability of utility patents for plants, thus affirming—rather than negating—the application to plants of the plain and judicially confirmed meaning of Section 101.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

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June 15, 2001